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EXAMINER	
OBEID, MAMON A	

ART UNIT	PAPER NUMBER
3621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/537,441	OTA, MICHIHIRO	
	Examiner	Art Unit	
	MAMON OBEID	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05/05/2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *24- 28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24- 28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgments

1. This is in reply to the amendment filed on May 5, 2008.

2. Claims 1- 23 have been canceled.

3. Claims 24- 25 have been amended.

4. Claims 24- 28 are currently pending and have been examined

Claim Rejections - 35 USC § 112- 2nd

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 24- 28, as best understood by the Examiner, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claims 24- 28, the specification does not clearly link the corresponding structure to:

i. "a first generating means for encrypting the card information with a first key to generate first information" as recited in at least claim 24.

ii. "a second generating means for encrypting the first information generated by the first generating means with a second key to generate second information" as recited in at least claim 24.

ii. "a card issuing information generating means for synthesizing the first information and the second information to generate third the card issuing information" as recited in at least claim 24.

iii. "a separating means for separating the first information and the second information from the card issuing information received from the mobile communication terminal" as recited in at least claim 24.

iv. "a fourth generating means for encrypting the first information separated by the separating means with the second key to generate authentication data corresponding to the second information" as recited in at least claim 24.

v. "a determination means for comparing the corregponding second information authentication data generated by the fourth generating means with the second information separated by the separating means, and determining that the card information included in the card issuing information is valid when the authentication data coincides with the second information encrypted by the encryption means" as recited in at least claim 24.

vi. "a sales performing means for performing sales processing based on the card issuing information when the card information is determined to be valid by the determination means" as recited in at least claim 24.

b. Claim 24 recites the limitation "the encryption means" in the sixth limitation. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 24- 28 are rejected under U.S.C §103 (a) as being unpatentable by Park et al (U.S. 2002/0194137 A1)("Park") in view of Haynes III et al. (U.S. 6,161,181)("Haynes").

9. **As per claim 24:** Park discloses the following limitation:

a. *a card information issuing server to issue card issuing information comprising card information* (see at least paragraph [0136], Figure 3 and related text);

b. *a mobile communication terminal to receive the card issuing information issued by the card information issuing server through wireless communication and to store the received card issuing information terminal* (see at least paragraph [0136], Figure 3 and related text);

c. *a sales processing device to receive the card issuing information from the mobile communication terminal and to perform sales processing based on the card issuing information* (see at least paragraph [0136], Figure 3 and related text);

d. *a settlement device to collect sales information from the sales processing device and to perform settlement processing on the sales information* (see at least paragraph [0005], Figure 2 and related text);

e. *wherein the card information issuing server comprises: a first generating means for encrypting the card information with a first key to generate first information* (see at least paragraph [0052];

f. *a second generating means for encrypting the first information generated by the first generating means with a second key to generate second information* (see at least paragraph [0052]);

g. *a fourth generating means for encrypting the first information separated by the separating means with the second key to generate authentication data corresponding to the second information* (see at least paragraph [0052]);

h. *a determination means for comparing the authentication data generated by the fourth generating means with the second information separated by the separating means with and determining that the card information included in the car issuing information is valid when authentication data coincides with the second information encrypted by the encryption means* (see at least paragraph [0271]);

i. *a sales performing means for performing sales processing based on the card issuing information when the card information is determined to be valid by the determination means* (see at least paragraph [0287]);

Park further discloses multiple card information encryption (see at least paragraphs [0184] and [0188]), but does not explicitly disclose *a third generating means for synthesizing the first information and the second information to generate third information* and *wherein the sales processing device comprises: a separating means for separating the first information and the second information from the card issuing information received from the mobile communication terminal.* However, Haynes, III et al., discloses means for packaging encrypted, double encrypted and/or digitally signed information (see at least Figure 7 and related text). Haynes further discloses separating means for separating two pieces of information in a package or in an envelope (see at least column 10, lines 45- 61 and Figure 4A).

Therefore, It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Park's teachings to include information that is encrypted in multiple stages and/ or includes digital signatures; wherein this information is to be synthesized or packaged together to form one common file, package or envelope to enhance privacy and to provide substantial improvements in security (see in Haynes column 12, lines 54- 62).

10. **As per claim 25:** Park further discloses multiple card information encryption (see at least paragraphs [0184] and [0188]), but does not disclose *wherein the card issuing information is information which is prepared by synthesizing the first information and the second information and encrypting the synthesized information with a third key,* and *the separating means separates the first information and the second information after*

decrypting the card issuing information with the third key. However, Haynes, III et al., discloses means for packaging encrypted, double encrypted and/or digitally signed information (see at least Figure 7 and related text). Haynes also discloses separating means for separating two pieces of information in a package or envelope (see at least column 10, lines 45- 61 and Figure 4A).

Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Park's teachings to include information that is encrypted in multiple stages and/ or includes digital signatures; wherein this information is to be synthesized or packaged together to form one common file, package or envelope to enhance privacy (see in Haynes column 12, lines 54- 62).

11. **As per claim 26:** Park discloses *wherein the second key is generated by using a password managed in confidence between the card information issuing server and the sales processing device or at least a part of the card information* (see at least paragraph [0271] and Figure 66).

12. **As per claim 27:** Park discloses *wherein the sales processing device is an automatic vending machine, which comprises sales permitting means for permitting the sales transaction using the card issuing information when the card information is determined to be valid by the determination means; and*
storing and accumulating means for storing and accumulating sales price information related to the sales transaction together with the first information when the sales

transaction permitted by the sales permitting means is executed (see at least paragraph [0223]).

13. **As per claim 28:** Park discloses the following limitations:

j. *collecting means for collecting the first information accumulated in the sales processing device and the sales price information; decryption means for decrypting the first information collected by the collecting means with the first key to obtain the card information* (an optical settlement operation wherein credit information is transmitted to the card company and wherein the card company performs a decryption process corresponding to the repeated encryption process (see at least paragraph [0196])).

k. *settlement means for performing settlement processing on the sales price information based on the card information decrypted by the decryption means* (a sale particulars settlement process wherein the sale particulars are recorded and stored (see at least paragraph [0223])).

Examiner's notes

14. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as

potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

15. Although Applicant(s) use "means for" in the claim(s) (*e.g.* claims 24- 28), it is the Examiner's position that the "means for" phrase(s) do not invoke 35 U.S.C. 112 6th paragraph. If Applicant(s) concur, the Examiner respectfully requests Applicant(s) to either amend the claim(s) to remove all instances of "means for" from the claim(s), or to explicitly state on the record why 35 U.S.C. 112 6th paragraph should not be invoked.

Alternatively, if Applicant(s) desire to invoke 35 U.S.C. 112 6th paragraph, the Examiner respectfully requests Applicant(s) to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. 112 6th paragraph, the "means for" phrase(s) will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6¶*.

16. In light of applicant's choice to pursue product claims, Applicants are reminded that functional recitation(s) using the word and/ or phrases "for", "adapted to" or other functional language (e.g. claim 24 recites *"a mobile communication terminal to…")* have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language (see e.g. *In re* Gulack, 703 F.2d 1381, 217 USPQ 401, 404(Fed. Cir. 1983, which states that although all the limitations must be considered, not all limitations are entitled to patentable weight). To be especially clear, all limitations have been considered. However, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to distinguish the claimed product from the prior art. If the prior art structure is capable to performing the

intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself".); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 31.06 II (c.), 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

Response to Arguments

17. Applicant's arguments filed on May 05, 2008, have been fully considered but they are not persuasive.

a. Applicants are reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

b. In response to Applicant's argument that Park et. Al reference does not disclose a sales processing device that includes a *""fourth generation means" to encrypt first information separated by a separating means in the sales processing devices";*. Applicant further argues that Park does not discloses the "fourth generation means..." step as recited above and said step of encryption occurs at at the (MU) 230 not at the (BU) 235 as claimed. However, the Examiner asserts that single, double or multiple layers of encryption is old and well know in the art for protecting confidential information and increasing secrecy. That is by encrypting credit card information twice with some block cipher, either with the

same key or by using different keys, the resultant encryption becomes stronger in all circumstances. And by using three encryptions, we would expect to achieve a yet greater level of security. Furthermore, It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art *(In re Dulberg, 129 USPQ 348, (CCPA 1961)*. The courts also has held that It would seem scarcely necessary to point out that merely making a two-piece handle in one piece is not patentable invention because it is an obvious thing to do if deemed desirable (*In re Wolfe*, 116 USPQ 443, 444 (CCPA 1961).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MAMON OBEID whose telephone number is (571)270-1813. The examiner can normally be reached on Mon-Fri 9:30 AM- 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mamon Obeid
Examiner
Art Unit: 3621
August 7, 2008

/ANDREW J. FISCHER/
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